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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,902	06/26/2003	Jeffrey Sutton	DEP5114	7208
27777	7590	05/27/2005	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			PEFFLEY, MICHAEL F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,902

Applicant(s)

SUTTON, JEFFREY

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-18, 20, 71 and 75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-18, 20, 71 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Applicant's amendments and remarks of February 25, 2005 have been fully considered by the examiner now of record. The current examiner has found new prior art and is making new rejections on the claims. Consequently, the instant Office action is non-final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-14, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Dobak, III et al (6,533,804).

Dobak, III et al disclose a therapeutic probe that includes proximal and distal portions, and a longitudinal portion (203,205,207) located between the proximal and distal portions. The longitudinal portion has an axial cross section defining an outer surface, and an energy delivery device (e.g. 304) is provided in the longitudinal portion. The energy delivery device is a tube that delivers fluid used to either heat or cool tissue through the outer surface of the longitudinal portion. The outer surface of the longitudinal portion comprises a threaded shape (Figure 6). The threadform is an expandable device adapted to conform to the contour of tissue and may be a balloon

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(i.e. inflatable member). With regard to claims 17 and 18, the examiner maintains the device is inherently capable of being used to treat intervertebral disc tissue.

Claims 71 and 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Panescu et al (6,895,267).

Panescu et al disclose a therapeutic probe that includes an elongate member having proximal (34) and distal (36) ends, and a longitudinal portion supporting energy delivery members (33,35,37). Panescu et al specifically teach that the energy delivery members may be selected from a number of types, including ultrasound transducers (col. 3, lines 15-17). The longitudinal portion is round having an axial cross section inherently creating top, bottom, front and back portions (i.e. 90 degree sections of the catheter). The longitudinal section may also be provided in a helical shape (Figure 2b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobak, III et al ('804) in view of the teaching of Hilal (5,411,509).

The Dobak, III et al device has been addressed previously. While Dobak, III et al disclose a helical shaped balloon member, there is no specific teaching of providing this portion with a malleable foam portion.

As discussed in the previous Office action, Hilal teaches of providing a foam portion on a catheter to allow the catheter to be shaped as desired without overinflating or puncturing.

To have provided the Dobak, III et al device with a malleable, foam material to provide a more resilient balloon member would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Hilal.

Claims 20, 71 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobak, III et al ('804) in view of the teaching of Knowlton (6,427,089).

The Dobak, III et al device has been previously addressed. Dobak, III et al teach that the probe may be used to heat and cool tissue (see Title), but only discloses the use of a fluid for performing this function.

With regard to claim 20, there is no specific disclosure in Dobak, III et al of using ultrasound transducers to heat tissue. Rather, only the use of a heating/cooling fluid is disclosed for transferring energy to tissue:

Knowlton also discloses a heat transfer catheter similar to the Dobak, III et al device. It includes a catheter with a distal heat transfer section (i.e. balloon). In particular, Knowlton teaches that it is known to use heated and cooled fluid to treat tissue, just as in the Dobak, III et al system. Knowlton further teach that alternative energy sources, including the use of ultrasonic transducers, may be used to provide heat energy to the fluid in the balloon (col. 8, lines 48-65). The examiner maintains that

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Knowlton teaches the use of many known energy sources to provide heat energy to tissue.

To have provided the Dobak, III et al device with ultrasonic transducers to provide heat energy to a fluid within the heat transfer catheter would have been an obvious modification for one of ordinary skill in the art, particularly since Knowlton teaches of the known use of such alternative energy sources to provide heat energy to heat transfer catheters.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

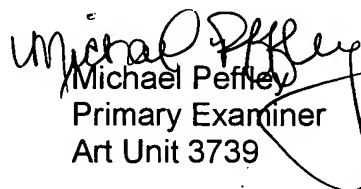
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vaska et al (6,314,963) discloses another catheter device that utilizes ultrasonic transducers to treat tissue. Dobak, III et al (6,254,626) disclose a heat transfer catheter with a threadform section.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

mp
May 24, 2005